

REMARKS

The Examiner requires restriction between claims 1, 2, 5, 8-9, 14, and 15 (Group I); claims 1, 4, 7-9, 14, and 15 (Group II); claims 1, 6, 8-9, 14, and 15 (Group III); claims 10, 16, and 20 (Group IV); claims 10, 16, and 20 (Group V), claims 10, 16, and 20 (Group VI), and claims 11-13, 17, 18, and 19 (Group VII). **Applicant provisionally elects Group III, drawn to a fungus belonging to *Talaromyces* or compositions thereof, for further examination of the above-identified application.** To place the claims in better form for allowance, Applicant submits herewith new claims that more particularly claim the invention. Applicant respectfully submits that the newly introduced claims are fully supported by the present specification. Newly introduced claims 21-24 correspond to Group III and are accordingly elected for further prosecution.

In the Office Action, the Examiner averred that the inventions I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons at pages 2-3 of the Office Action.

As a preliminary matter, Applicant respectfully submits the examining division has already found during the international proceedings of the above National Stage application that claims 1-20 fulfill the Unity of Invention requirement under PCT Rule 13.2.

Notwithstanding, the inventions in claims 21-31 presented herein relate to a single general inventive concept under PCT Rule 13.1. Applicant respectfully submits that the each of the claimed inventions recite a number of special technical features that define a contribution which, considered as a whole, makes over the prior art. For example claim 21, in (Group III), recites "[a] biologically pure fungal isolate having all the identifying characteristics of *Talaromyces* sp. B-422 strain having the accession number FERM BP-08516," a requirement common to all of the claims. Without in anyway acquiescing to the Examiner's assertions made at page 3 of the Office Action referring to Renwick, 1991, Plant Pathology, 40 (4):524-532, this reference does teach or suggest the fungal isolate required by the claims. Without regard to whether the inventions are claimed in separate claims, the group of inventions is so linked as to form a single general inventive concept.

The Examiner identifies Group VI as being directed to a method of controlling disease in a Graminaceous plant or plant seed thereof by using a fungus belonging to *Talaromyces* or

compositions thereof. Newly introduced claims 25 and 26, which depend from claim 21, correspond to Claim VI. Claims 25 and 26 are directed to methods of controlling disease using a fungus belonging to *Talaromyces* that is recited in claim 21. Applicant respectfully submits that claims 25 and 26 corresponding to Group VI be rejoined when claims 21-24 are found to be allowable pursuant to MPEP §§ 821.04. Furthermore, if the elected product invention is found allowable, the process claims are eligible for rejoinder. See MPEP § 821.04(b). Accordingly, upon full examination and a finding of allowance of the product claims 21-24, the method claims that recite, and include all of the limitations of, the product claims are appropriate for rejoinder.

Applicant respectfully requests that the remaining claims, claims 27-31, should also be examined / rejoined in this application. As discussed above, the inventions in claims 21-31 relate to a single general inventive concept under PCT Rule 13.1. Further, PCT Rule 13 permits combinations of different categories of claims in one application. The Examiner relied heavily on PCT Rule 13 in imposing the restriction requirement. However, the same rules support against the restriction requirement at least insofar as claims 21-31 are considered. In the alternative, Applicant believes that claims 27-31 (nonelected inventions), which depend from or otherwise require all the limitations of independent claim 21, are eligible for rejoinder pursuant to MPEP §§ 821.04 in the event that the claims to the elected invention are found allowable.

Applicant respectfully submits that the subject matter of claims 21-31 are sufficiently related so that a thorough search for the subject matter of one group of claim(s) would necessarily encompass a search for the other groups of claims. In addition, the International Searching Authority has already searched prior art with respect to the related claims in the corresponding PCT application. Thus, Applicant respectfully submits that all the claims can be searched and examined without any serious search burden to the Examiner. This fact may be illustrated by comparing the claims in the instant case to those in the U.S. Patent 7,378,399. That patent has issued with 6 different categories of claims; claim 1 is directed to a compound; claim 2 is directed to a composition; claim 3 is directed to a method for controlling pests, claim 4 is directed to a process for preparing a composition, claim 5 is to a method for protecting plant propagation material and claim 6 is drawn to a plant propagation treated according to the method of claim 5. These different categories of claims were examined in the same application before it matured into U.S. Patent 7,378,399. Likewise, the instant claims can also be examined without serious search burden on the part of the Examiner.

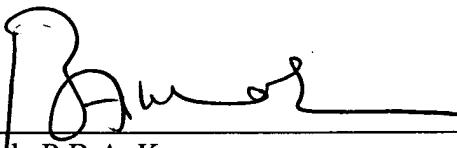
It is further submitted that in view of the fees charged for filing of divisional patent applications, and prosecution and maintaining the resulting patents place an undue burden on the Applicant, which justifies that any restriction or election requirement be clearly supported and made according to the patent examining procedure.

Applicant reserves the right to file during the pendency of the present application one or more divisional applications directed to the non-elected and/or canceled claims.

Based upon the above remarks, Applicant respectfully requests reconsideration of this restriction requirement and early allowance of the pending claims. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite prosecution of this application, the Examiner is urged to contact the undersigned attorney.

Respectfully submitted,

By


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